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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/631,928	07/31/2003	Clifford Teoh	01-170 (US02)	9672
41696 7590 01/21/2009 VISTA IP LAW GROUP LLP 12930 Saratoga Avenue Suite D-2 Saratoga, CA 95070				
EXAMINER				
NGUYEN, VI X				
ART UNIT		PAPER NUMBER		
3734				
MAIL DATE		DELIVERY MODE		
01/21/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/631,928

**Applicant(s)**

TEOH ET AL.

**Examiner**

Victor X. Nguyen

**Art Unit**

3734

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-7,9,10,13 and 14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5-7,9,10,13 and 14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The request filed on 08/27/2008 for Continued Examination (RCE) under 37 CFR 1.114 based on parent Application No. 10/631,928 is acceptable and a RCE has been established. An action on the RCE follows.

#### ***Specification***

2. The abstract of the disclosure is objected to because the new abstract should relate to method claims as the new amended claims relate to method while the original abstract submitted on 7/31/2003 relates to device claims. Correction is required. See MPEP § 608.01(b).

#### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,2,5-7,9,10,13-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Van der Burg et al. (7,128,073).

Van der Burg et al disclose in figures. 11 and 12, an assembly for treating an aneurysm, including: a structure 102 is considered as a liner which has a proximal portion (at 101), a distal portion (at 103) which definitely has an interior within the proximal and distal portions, and where the distal portion is more permeable than the proximal portion (in fig. 12, Van der Burg discloses a different braided pattern occurred to the right side of 101

which definitely has plurality of apertures or gaps which is inherently more permeable than the proximal portion which has smaller perforations; therefore, at the distal portion it is preferentially permeated embolics from the interior). The intended use of introducing embolics through an opening in the proximal portion of the liner into an interior of the liner, where the distal portion of the liner allows preferential permeation of the embolics from the liner interior into the sac of the aneurysm must result in additional steps to be performed between the claim invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Since the prior art is capable of performing the intended use, then it meets the claim; see MPEP 2106, and where an elongated delivery member 85 releasably connected to the liner (see fig. 12) as recited in claim 14. As to claims 2,5-6 and 13, Van der Burg discloses the structure or the liner is comprised of a biodegradable (see col.5, lines 49-59, furthermore, the specification of the present application lists PGA or PLA as one of biodegradable material) and biocompatible material (see col.7, lines 49-56), where the distal portion has perforations sized to permeate embolics, and where the liner proximal portion is configured to permeate blood (a functional limitation) but to inhibit permeation of embolics (see col. 8, lines 53-58): Thus, a reference needs not show the structure of the recitation in order to meet the claim language but rather the reference needs only be capable of being used with such structure. It is noted that the procedure of fig. 6 discloses the distal portion is formed of the struts which is free of any covering. As to claims 7, 9,10 Van der Burg discloses that the liner distal portion is comprised of a liner 102 supported by the struts (see fig. 12), and where the liner portion comprises a shape memory polymer material (it is noted that

the liner portion is made of weaved or braided mesh which has some form of a shaped memory polymer material such as polyurethane or nitinol), and the shape memory polymer is actuatable between the first low profile delivery configuration where it confines the struts to a low profile configuration (see fig. 11) and a relaxed, expanded configuration (see fig. 12).

#### ***Response to Arguments***

4. Applicant's argument filed 8/27/2008 have been fully considered but they are not persuasive. In response to applicant's argument, the recitation that "a method of occluding an aneurysm having a neck and a sac" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Therefore, "treating of occluding an aneurysm" is taken to be statements of intended use and is of no significant in the claim construction. Furthermore, both inventions claim using embolics or occlusive coils 149 through an opening into the interior of the liner (see fig. 19, col. 11, lines 5-11 of Van der Burg). Applicant is asked to please refer to the modified prior art rejections above where examiner address applicant's concerns regarding prior art rejection.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor X. Nguyen whose telephone number is (571) 272-4699. The examiner can normally be reached on M-F (8-4.30 P.M).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ho Jackie can be reached on (571) 272-4697. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kevin T. Truong/  
Primary Examiner, Art Unit 3734

/Victor X Nguyen/  
Examiner  
Art Unit 3734

VN